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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,815	04/20/2000	Steven G. Goldstein	50N3483/1333	4648

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 11/05/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/552,815

Applicant(s)
Goldstein et al

Examiner
Mark Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 18, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 8/18/2003.

2. This application has been reconsidered. Claims 1-69 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1, 2, 3, 5, 6, 11, 12, 13, 14, 15, 16, 17, 22, 23, 24, 25, 26, 28, 29, 34, 35, 36, 37, 38, 39, 40, 45, 46, 47, 66, 67, 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Bell et al (Bell) (U. S. 6,147,742).

With respect to claims 1, 3, 5, 12, 15, 22, 23, 24, 26, 28, 35, 38, 45, 46, 66, 67, 68 Bell discloses a system (figure 1) for transferring image data to a service provider (40) comprising an image source (camera 26) configured to provide the image data; and an image pump (which reads on the order manager) (22) configured to receive image data from the image source (column 3, lines 60-67) by a hard-wired connection (net), and responsively provide the image data to the service provider (the abstract), the image pump implemented separately from the image source (26) and the service provider (40) in a non-integral manner (figure 1) for transferring the image data from the image source to the service provider (the abstract and column 3, lines 60-62); the image pump being implemented without an internal processor or video display (figure 1) (there is no indication in Bell that the order manager contains a processor or video display), and a user signals the image pump to transfer data (column 5, lines 1-32).

With respect to claims 2 and 25, Bell discloses a photofinishing system wherein audio data is coupled with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17).

With regard to claims 6, 11, 29, and 34, Bell discloses the data source stores the data on removable storage (column 3, line 60 to column 4, line 3).

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With respect to claims 13, 16, 36, and 39, Bell discloses the image pump configures the data to conform to a format required by the service provider (column 2, lines 30-38).

With regard to claims 14, 17, 37, 40, and 47, Bell discloses the image pump includes customer information that is communicated to the service provider (column 5, lines 1-11).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 48, 49, 50, 51, 58, 59, 60, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Enomoto.

With respect to claim 48, Enomoto discloses capturing image data utilizing an image source (20 or 21); sending the image data to an image pump (11); attaching customer account

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information to the image data (column 3, line 64 to column 4, line 4); sending the image data and customer account information to the service provider (column 6, lines 44-50); determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7, lines 4-8); providing services by the service provider (column 7, lines 23-40, and returning a final product to the user, along with a bill (column 7, line 41 to column 8, line 12).

With respect to claims 49, 50, and 51, Enomoto discloses a system for transferring image data to a service provider (12), comprising an image source (20 or 21), and an image pump (which reads on computer 11) configured to receive the image data from the image source by a hard-wired connection (column 6, lines 23-32), and provide the image data to the service provider (column 6, lines 44-50), the image pump (11) being implemented separately from the image source (20 or 21).

With respect to claims 58 and 59, Enomoto discloses attaching customer information to the data (column 3, line 64 to column 4, line 4).

With respect to claim 60, Enomoto discloses capturing image data utilizing an image source (20 or 21); sending the image data to an image pump (11); attaching customer account information to the image data (column 3, line 64 to column 4, line 4); sending the image data and customer account information to the service provider (column 6, lines 44-50); determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7,

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lines 4-8); providing services by the service provider (column 7, lines 23-40, and returning a final product to the user, along with a bill (column 7, line 41 to column 8, line 12).

With regard to claim 61, Enomoto discloses configuring the image data to conform to a format required by the service provider (column 3, lines 41-60).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 62 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (U. S. 6,167,469).

With respect to claim 62 and 64, Safai discloses capturing image data by utilizing an image source (100); providing the image data to an image pump (figure 2) integral with the camera;

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converting the image data to a format compatible with the service provider (column 5, lines 28-62 and column 7, lines 14-50); attaching user defined instructions and customer account information (column 7, lines 32-50 and column 15, lines 16-27); transferring the image from the image pump to the service provider (column 2, lines 1-3); reviewing the order and providing services to the user (column 9, lines 30-45).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 18, 19, 27, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Cok (U. S. 6,157,436).

With respect to claims 4 and 27, Bell differs from claims 4 and 27 in that he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means (column 7, lines 35-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to obtain data from different sources.

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With respect to claims 18, 19, 41, and 42, Bell differs from claims 18, 19, 41, and 42 in that he does not clearly disclose a touch screen. Cok discloses an operator station comprising a CRT or LCD screen wherein an operator can use any suitable input device to enter print order information on the screen (column 8, lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein a touch screen is used to enter print information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to achieve ease of operation.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 8, 9, 10, 20, 21, 30, 31, 32, 33, 43, and 44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Enomoto (U. S. 5,974,401).

Bell differs from claims 7, 8, 9, 10, 30, 31, 32, and 33 in that he does not clearly disclose the type of connection between the Image pump and the service provider. Enomoto discloses communicating with the service provider via a wireless (radio telephone line); hard-wired (cable); Ethernet (which reads on a network such as the Internet), or a public switched telephone network (column 3, lines 21-30 and column 4, lines 61-65). Therefore, it would have been obvious to one

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of ordinary skill in the art at the time of the invention to have modified Bell wherein different transmission methods are user to transmit image data to the service provider. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to allow the service provider to receive data from different sources.

With respect to claims 20, 21, 43, and 44, Bell differs from claims 20, 21, 43, and 44 in that he does not clearly disclose determining user selections and transferring the selections to the service provider. Enomoto discloses determining user selections and transferring the selections to the service provider (column 6, lines 44-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein user selections are determined and transferred to the service provider. It would have bee obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to achieve ease of operation.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell et al (Bell) (U. S. 6,147,742).

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With respect to claim 52, Enomoto differs from claim 52 in that although he discloses the image source is a camera, he does not clearly disclose receiving audio data from the image source. Bell discloses a photofinishing system wherein audio data is coupled with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto wherein audio data is received from the image source. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to allow for a variety of output media and formats as disclosed by Bell in column 2, lines 25-29.

15. Claims 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell.

With respect to claim 53, Enomoto differs from claim 53 in that he does not clearly disclose source transfer means external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider. Bell discloses source transfer means (the order manager) external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider (column 4, line 42 to column 5, line 60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to simplify the system.

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With respect to claim 57, Enomoto differs from claim 57 in that he does not clearly disclose that the image pump does not have a video display and a user signals the image pump to transfer data. Bell discloses an image pump (34) that does not have a video display and a user signals the image pump to transfer data (column 5, lines 1-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to simplify the system.

16. Claim 54, is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell as applied to claim 53 above, and further in view of Cok.

With respect to claim 54, Enomoto as modified differs from claim 54 in that although he discloses transferring the data to the service provider in a cable or wireless manner (column 4, lines 61-65), he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means or disk (112) and transfers the data to the photofinisher (160) by wireless, disk or cable means (column 7, lines 4-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Cok in order to obtain data from different sources.

17. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell.

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With respect to claims 55 and 56, Enomoto differs from claims 55 and 56 in that although he discloses downloading and executing an image pump manager program (processing-ordering software) (column 6, lines 10-18) allowing a user to view and select individual images to be processed (column 6, lines 44-50) and attaching specific instruction to the images (column 6, lines 44-64), and then uploading the desired images to the service provider (column 6, lines 44-50), he does not clearly disclose that the image pump is implemented without a processor.

Bell discloses an image pump (22) implemented without a processor. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto wherein the image pump is implemented without a processor. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to achieve ease of operation.

18. Claims 63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai in view of Enomoto.

With respect to claim 63, Safai differs from claim 63 in that he does not clearly disclose that the image source is a scanner. Enomoto discloses a scanner as an image source (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to vary the image sources.

With respect to claim 65, Safai discloses including customer account information (column 15, lines 17-27). Safai differs from claim 65 in that he does not disclose determining if the image

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data and customer information have errors, and requesting the image pump to re-transmit the image data and customer information if errors are detected. Enomoto discloses determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7, lines 4-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to improve the image system.

19. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Cok.

With respect to claim 69, Bell differs from claim 69 in that although he discloses transferring the data to the service provider in any means of a network (figure 1), he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means or disk (112) and transfers the data to the photofinisher (160) by wireless, disk or cable means (column 7, lines 4-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to obtain data from different sources

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Response to Arguments

20. Applicant's arguments filed 8/18/2003 have been fully considered but they are not persuasive.

Applicant submits that *Bell* fails to disclose an image pump that is “implemented separately from the image source and service provider in a non-integral manner, for transferring said image data from said image source to said service provider”, and that the rejections under § 102(e) are improper. The Examiner notes that this is newly added subject matter. Accordingly, the rejections cannot be improper if the Examiner has not had a chance to address the new subject matter. Applicant cannot presumptively assert that the Examiner's rejections are improper if the Examiner has not made those rejections.

With regard to Applicant's assertions, *Bell* discloses an image pump (the Examiner submits that the order manager (22) equates to the image pump), implemented separately from the image source (26) and service provider (40), (figure 1 clearly depicts the order manager (22) implemented separately (and in a non-integral manner) from the image source (26) and the service provider), for transferring image data from the image source to the service provider (column 4, lines 25-37).

With respect to Applicant's arguments pertaining to claims 48-51 on pages 20-21 of the Amendment filed on 8/18/2003, it is unclear to the Examiner where the arguments pertaining to claims 1 and 24 end and the arguments pertaining to claims 48-51 begin. Applicant argues that claims 1 and 24 recite an image pump that is implemented without an internal processor.

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However, this argument has no relevance to claims 48-51, which do NOT recite an image pump implemented without an internal processor. Claims 1 and 24 were rejected as being anticipated by *Bell*, not *Enomoto*.

Applicant also submits that *Enomoto* does not disclose reviewing the image data and customer information for accuracy. *Enomoto* clearly discloses reviewing the image data and customer information (print order) for accuracy (column 6, line 55 to column 7, line 8).

With respect to claim 60, *Enomoto* clearly discloses determining if the image data and customer information have errors (which reads on if the delivery data exceeds the expected delivery date) (column 7, lines 4-8).

With regard to claim 54, *Cok* clearly discloses receiving image data from an image source via various communications media and transmitting the image data to output devices via various communications medium (column 7, lines 12-40).

In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

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Sixth Floor (Receptionist)


MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON